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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,773	01/21/2004	Terry Durand	8C20.1-220	3533
36513 7590 07/09/2008 GARDNER GROFF GREENWALD & VILLANUEVA, P.C. 2018 POWERS FERRY ROAD SUITE 800 ATLANTA, GA 30339				
EXAMINER				
KEEFE, MICHAEL E				
ART UNIT		PAPER NUMBER		
2154				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@gardnnergroff.com

### Office Action Summary

**Application No.**

10/761,773

**Applicant(s)**

DURAND ET AL.

**Examiner**

MICHAEL E. KEEFER

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-10, 13, 15-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 15-23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is responsive to the Amendment filed 3/17/2008.

#### ***Election/Restrictions***

2. The Examiner notes that by the amendment filed 3/17/2008 Applicant has changed the independent claims to include subject matter that causes the claims to no longer be generic claims as they no longer read upon the previously elected species 1.

#### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The term "computer-readable medium" as recited in claim 25 is not found in the specification.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-6, 8-9, 15-18, 20-22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Isaacs et al. (US 2004/0215728), hereafter Isaacs.

Regarding **claims 1, 15, and 25**, Isaacs discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server ([0038], "The missing sound message may ... be requested ... from a central server...") for facilitating communications between the sender and the recipient, the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message; and (Fig. 3, step 144)

forwarding the emoticon and its link to the sound file to the recipient. (Fig. 3, 152, [0007] "Visual aids may be provided to aid users in learning the meaning of the earcons." Furthermore see [0030] which discloses displaying a visual log of the earcons)

determining if the recipient already has the sound file, if not sending the sound file to the recipient (see Fig. 5, steps 220, 240, 250)

at the recipient displaying the emoticon and audibly playing the sound file linked to the emoticon.(see Fig. 5 step 230, also see [0030] which displays the emoticons ("earcons"))

Regarding **claims 3 and 16, as applied to claims 1 and 15**, Isaacs discloses:

making a dynamic association, established by the sender, for that particular message being sent. (Fig. 3 discloses linking particular sounds to particular icons creating specific 'earcons', which are particular messages made by the user dynamically.)

Regarding **claims 4 and 17 as applied to claims 1 and 15**, Isaacs discloses:

automatically generating a link according to the particular emoticon being sent. ([0031] discloses that a sound is automatically chosen based upon the icon chosen by the user for the message.)

Regarding **claims 5 and 18 as applied to claims 1 and 15**, Isaacs discloses:

automatically generating a link according to the combination of the particular emoticon being sent and the particular recipient. ([0021] discloses sending different sounds to different recipients depending upon the particular recipient (i.e. has that recipient received a message from the user within a certain amount of time, if not, link a sound file including the user's personal sound.)

Regarding **claims 6 and 20, as applied to claims 1 and 15**, Isaacs discloses:

wherein the step of linking is performed by the sender. (Fig. 3)

Regarding **claims 8 and 21, as applied to claims 1 and 15**, Isaacs discloses:

wherein the step of linking comprises attaching the sound file to the message, and wherein the step of forwarding comprises forwarding both the message and the sound file. ([0039] discloses sending a sound file with the message.)

Regarding **claims 9 and 22, as applied to claims 1 and 15**, Isaacs discloses:

creating a pointer to a sound file and attaching the pointer to the message. ([0037] discloses including a unique ID that indicates the sound file with the message.)

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 7, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann et al. (US 6963839), hereafter Ostermann in view of Issacs.

Regarding **claims 1 and 15**, Ostermann discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, (Fig. 4(a), 4(b)) the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message; and forwarding the emoticon and its link to the sound file to the recipient. (Col. 8, lines 17-28 disclose linking video and audio to a sender-generated message containing emoticons. Col. 9 lines 59-61 disclose determining sounds to link with the message based off of emoticons. It is inherent that the message is forwarded to the recipient, or else there would be no reason to construct it at all. (Note recipients 72 and 76 in fig. 4a and 4b)

Regarding **claims 7 and 19 as applied to claims 1 and 15**, Ostermann discloses:

The linking is preformed on the server. (Col. 8 lines 17-28 disclose that the linking is done by a server.)

Ostermann discloses all the limitations of claims 1, 7, 15 and 19 except for determining if the recipient has a file prior to sending the file.

The general concept of allowing a recipient to cache files is well known in the networking art as taught by Issacs (see Fig. 5, steps 220, 240, and 250).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ostermann with the general concept of allowing a recipient to cache files as taught by Issacs in order to decrease network traffic and message size.

8. Claims 1, 10, 15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al. (US 6463467), hereafter Mages in view of Issacs.

Regarding **claims 1 and 15**, Mages discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, the method comprising the steps of: linking a sound file to an emoticon contained in a sender-generated message; and forwarding the emoticon and its link to the sound file to the recipient. (Col. 3 lines 5-32. disclose the MIME protocol, used in email, which inherently includes a sender, recipient, and email server. An email message is created including a graphic (i.e. an icon/emoticon) and audio, (i.e. the multi-part field described in lines 15-16, graphics and audio are disclosed in lines 5-6, the

email is then sent to the recipient. The graphic and sound are linked because they are in the same message.)

Regarding **claims 10 and 23 as applied to claims 1 and 15**, Mages discloses:

forwards the emoticon and its link to the sound file in the form of a MIME-encoded attachment. (Col. 3, line 5 discloses using MIME encoded attachments.)

Mages discloses all the limitations of claims 1, 7, 15 and 19 except for determining if the recipient has a file prior to sending the file.

The general concept of allowing a recipient to cache files is well known in the networking art as taught by Issacs (see Fig. 5, steps 220, 240, and 250).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Mages with the general concept of allowing a recipient to cache files as taught by Issacs in order to decrease network traffic and message size.

### ***Response to Arguments***

9. Applicant's arguments filed 3/17/2008 have been fully considered but they are not persuasive.

10. First, Applicants arguments regarding Mages and Ostermann are moot based upon the new rejections necessitated by Applicant's amendment.

11. Second, regarding Applicant's argument that Issacs only transmits sound, the Examiner has pointed out that in both paragraphs 7 and 30 Issacs discusses a visual cue associated with an "earcon". Given the visual log to enhance the user's ability to learn 'new' earcons, the visual cues must be transmitted with the earcons, or else a



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visual log feature would be useless, as the user would have no visual cue for any earcons received.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL E. KEEFER** whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 7/2/2008

/Joseph E. Avellino/

Primary Examiner, Art Unit 2146